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EXAMINER

CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,660

Applicant(s)

VEIGA, JOSE CARLOS
CARVALHO

Examiner

Erica E Cadugan

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figures 1-6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “storage space with divisions” of claim 25 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. As such, claims 1-26 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention.

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Examples of these instances are listed below, but these instances are not limited to the listed examples. Applicant is advised to closely review the claims for other occurrences.

Examples of such grammatical and idiomatic errors are: “in which a support base is angle bracket” in claim 4; “in which a second platform (2) comprising two pairs of rollers (4), respectively set apart from each of the rolls to form and guide the strips (1a, 1b), as these are being unrolled from the rolls”...(no verb modifying the “second platform” to complete the “in which a second platform” phrase), for example (a similar situation exists in claims 10 and 15, for example). Also note that there are typographical errors in the claims as well, such as “Potable platform” in claim 12.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. A few examples of this are: “the mandrel” in claim 1, line 3 and claim 26, line 3 (previously “at least one”); “the tool” in claim 1, line 4 and claim 26, line 4 (previously “at least one”); “the gasket-forming elements” in claim 1, line 4 and claim 26, line 4. This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

Claims 10 and 11 each depend from themselves, rendering it unclear what limitations they are intended to include. For purposes of expediting prosecution, Examiner is considering these claims with respect to the prior art as though they depended from claim 1.

In claim 2, for example, grammatically, it appears as though the claim sets forth that the mandrel is both a “roller” and a “tool consisting of a pressing device”, and also “at least one second roller”.

In claim 2, for example, it is unclear to what “it” refers.

Throughout the claims, there are many instances where an indefinite article such as “a” or “an” is used to refer to a claim element which was already previously set forth in the claims, rendering it unclear whether the later occurrence with the indefinite article is the same as or different from the previously-set-forth element. For example, in claim “a second roller” is set forth in lines 4-5, but the claim already set forth “at least one second roller” in line 3. This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 25 recites the broad recitation “objects”, and the claim also recites “especially tools” which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 12, and 24, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,499,521 (Luikart et al.).

Luikart teaches a portable device (note that the device is on wheels 16, see Fig. 1). Note that the surface of the device on which the “mandrel” 28 is located forms a “platform” surface. “Mandrel” 28 is motor-driven (see col. 3, lines 41-52). Additionally, the roller pairs 44 are considered the claimed “molding tool” (see Fig. 1) since they press the workpiece P against the “mandrel” 28 so that it may be formed as viewed in Fig. 1.

Regarding claim 24, note that the motor is located within housing 18 (see col. 3, lines 41-52).

Regarding the “for use in the manufacture of gaskets” language, for example, note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, there appears to be no reason why Luikart’s device couldn’t be used in the “manufacture of gaskets” as claimed.

Also, regarding the “mandrel and the tool” being “replaceable” by “another mandrel and another tool with different characteristics, the “mandrel” 28 and the “tool” 44 are considered to

be “replaceable” in that they are “able” to be replaced by being removed and having another mandrel/tool attached in their place.

7. Claims 1-3, 7, 9-11, and 25, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Pat. No. 3,905,090 (Painter).

Painter teaches a table or “platform” used to make spiral wound gaskets (see abstract, title, for example), which platform is considered to be “portable” in that it is “able” to be transported from one place to another, e.g., by forklift (see Fig. 1, also col. 1, lines 58-60 and col. 2, lines 20-44). The “platform” includes a roller or “mandrel” 20 that is rotated by an electric motor (Fig. 1, col. 3, lines 41-42, for example). Additionally, the device includes at least one “molding tool”, constituted by roller 22 which extends and retracts in the vertical direction shown in Figure 1 via pneumatic cylinder 24 (see Fig. 1, also col. 3, lines 40-47). It is noted that both the extendable/retractable roller 22 and the “mandrel” 20 are considered to be “replaceable” as claimed in that they are inherently “able” to be replaced, i.e., by removing the old one (22/24 and/or 20) and attaching a new “mandrel” and “tool” with whatever characteristics are desired. Note also that the “molding tool” 22 is inherently ultimately received by some “surface” since it is not suspended in mid-air.

Specifically regarding claim 3, note that whatever portion of the cylinder 24 is used to mount the cylinder can be considered the claimed “support base”, and that as it inherently must be connected to some surface as described above, whatever surface that is considered to be the claimed “platform surface” (noting that claim 3 does not specify that the platform surface is a surface of the previously-claimed “platform”).

Specifically regarding claims 9-10, note that Painter teaches a pair of rolls 18, 14, from which strip material is fed to the two rollers 20, 22 (Figure 1), and that two pairs of rollers (42, 44, and 46, 48) “form and guide” the strips as they are being unrolled (Fig. 1, also Figures 4-7).

Specifically regarding claim 9, while Painter is silent about the specific structure on which the rolls 18, 14 are mounted, it is noted that the rolls 18, 14 at least ultimately have to be supported by the floor, and that the floor can be considered the “second platform” as broadly claimed.

Likewise, regarding claim 10, as best understood, the floor can also be considered the “second platform” as broadly claimed since the rollers 42, 44, 46, and 48 ultimately must be supported by the floor.

Regarding claim 11, note also that the rollers 42, 44, 46, and 48 have “cooperative side edges with a transversal V-section” (see Figures 4-5).

Regarding claim 7, note that the material strip 12 is explicitly described as “metal” (col. 3, lines 32-33, for example).

Regarding claim 25, note that as claimed, the top of the table is “divided” by, for example, the strips 16 and 12 and the gasket 10 into at least upper and lower portions as viewed in Figure 1, and that there appears to be nothing preventing the “storage” of “objects” such as “tools” on the upper surface of the table in the positions where nothing is currently located (see Figure 1).

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 24, as best understood, is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Pat. No. 3,905,090 (Painter) as applied to claim 1 above.

Painter teaches all aspects of the claimed invention as described in the above rejection based thereon, and additionally regarding claim 24, while the motor that drives the roller 20 is not shown, it is inherently considered to have a housing since without such, the motor would not function efficiently (for example, without a housing, dust and other debris would get into the motor parts and hamper its operating effectiveness).

In the alternative, Painter does not explicitly teach that the motor has a housing. However, it is noted that motor housings are conventional and are widely used throughout industry to protect the inner workings of the motor, thereby increasing the life of the motor by protecting it from damage, and also thereby increasing the motor's efficiency by keeping it from being degraded by dirt and debris getting into the motor working parts.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the motor taught by Painter with a motor housing for the purposes of protecting the inner workings of the motor, thereby increasing the life of the motor by protecting it from damage, and also thereby increasing the motor's efficiency by keeping it from being degraded by dirt and debris getting into the motor working parts, as is conventionally known.

Claim Rejections - 35 USC § 103

10. Claims 4-6, and 8, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,905,090 (Painter).

Painter teaches all aspects of the claimed invention as described in the above rejection based thereon. Additionally, regarding claim 6, note that the rollers 20, 22 are considered to possess the claimed “transversal V-section” that are “cooperative with one another” as claimed (see Figure 10). Particularly regarding the roller 20, note that Painter explicitly teaches that the periphery of the roller 20 is made of rubber (col. 3, lines 40-41), and that the gasket material is preformed to the V-shape prior to its arrival at roller 20 via rollers 42, 44, 46, 48 (see Figures 1, 4-9). Thus, the rubber of the roller 20 when pressed against the gasket material as shown in Figures 1 and 10 will inherently at least somewhat conform to the V-shape of the gasket material.

Regarding claims 4-5, Painter does not explicitly teach the use of an “angle bracket” or “bolts”, and is in fact silent about the structure used to mount the cylinder 24 as well as the structure used to mount the roller 20.

Additionally, regarding claim 8, painter teaches the two strips 16 and 12, and specifies that one strip is metal (col. 1, line 61 through col. 2, line 13), and also teaches that the other strip may be of “any suitable and/or conventional material” (col. 2, lines 14-19, for example). However, Painter is does not explicitly teach that such other strip is made of “graphite material” as claimed.

Regarding claims 4-5, it is noted that both an angle bracket for attachment of a part and the use of bolts as claimed are conventionally known means of mounting a part.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized well-known mounting structures such as an angle bracket and bolts to mount the cylinder 24 and the roller 20 (just bolts for the roller) depending on design requirements such as space considerations, availability of a particular mounting structure, and cost of a particular mounting structure, for example.

Regarding the material of claim 8, particularly since Painter teaches that the filler strip material “may be of any suitable and/or conventional material” as described previously, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized whatever known material (such as graphite) for the filler strip as was desired or expedient, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

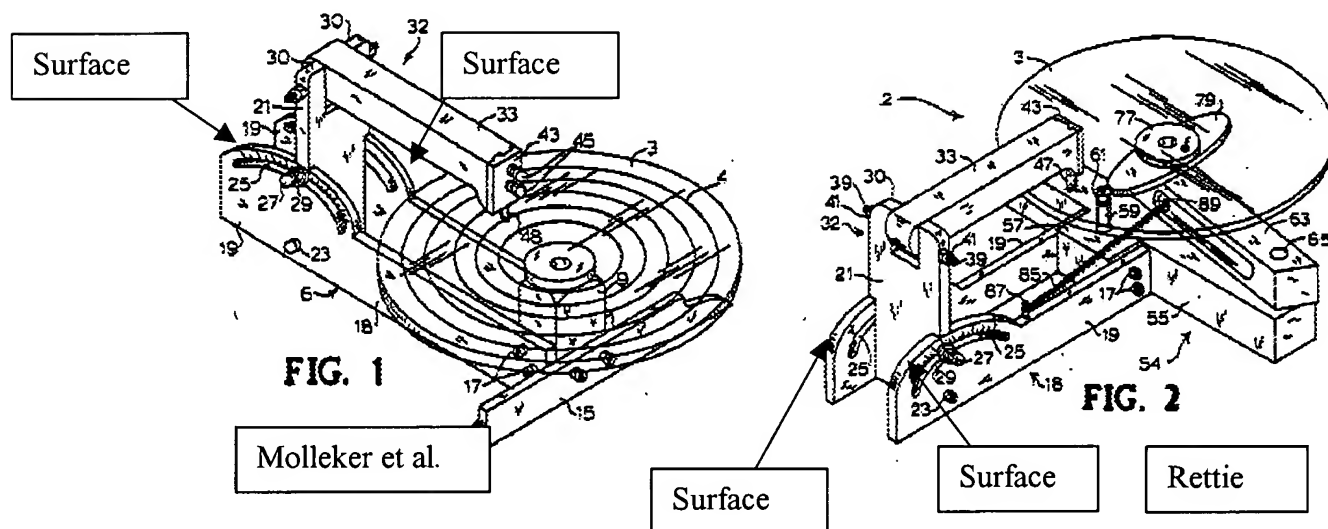
11. Claims 1, 19-24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over either of U.S. Pat. No.’s 5,009,138 (Rettie) or 5,044,245 (Molleker et al.).

Both Rettie and Molleker teach devices with rotary turntables 3 (see Figure 1 of both and also Figure 2 of Rettie) on which a workpiece such as one made of gasket material or rubber (see Molleker, col. 5, lines 16-21 and Rettie, col. 7, lines 19-25) is mounted so as to be rotated relative to a cutting blade (48 in Molleker, see Fig. 1, 47 in Rettie, see Fig. 2) to thereby cut the material. Thus, the turntables 3 constitute the claimed “mandrel”.

Additionally, the devices each include a “platform” in that they each have members with upper generally horizontal surfaces (see Figures 1-2 of each).

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Note that the cutting blades previously described as well as the “mandrels” 3 are considered to be “replaceable” in that they are “able” to be “replaced”. For example, Molleker explicitly teaches that the cutting blade is “replaceable” (col. 4, lines 12-29), and it is noted that Molleker’s platform 3 is “replaceable” in that it “can” be removed (either with member 5 or separately therefrom), see Figures 1-2. Additionally, likewise, Rettie explicitly teaches that the cutting blade is replaceable (Figures 1-3, col. 4, line 56 through col. 5, line 30, for example). Additionally, regarding Rettie, it is noted that the platform 3 is “replaceable” in that it “can” be removed (either with member 77 or separately therefrom).



Regarding claim 19, as illustrated in the indicated reproduced figures, both the device taught by Molleker and the device taught by Rettie have “the claimed “surfaces” that support “rods” 21, which rods 21 each support the cutting blades.

Regarding claim 20, note that pivot screws 23 serve to “attach” the support rods 21 to their respective “platforms”, pivot screws 23 are “fixed in relation” to the “platform”, and that the rods 21 are “mobile” in relation to the screws 23 in that they pivot about them to enable the

cutter blades to be moved towards and away from the turntables 3 (see Figures 1-2), and thus the pivots 23 are considered the “support” as claimed.

Regarding claim 23, as best understood, the pivot members 23 are attached by “bolts” to the “platform”. Additionally, the “turntables” are also ultimately connected to the “platform” by “bolts” such as 17 (Figure 2 of both references).

However, while both Molleker and Rettie teach that the turntable 3 is rotatable, neither specifies what causes the rotation, and thus neither explicitly teach a “motor” as set forth in claim 1.

However, it is noted that motors are extremely well-known as devices which provide rotation to a rotating member. Additionally, specifically claim 24, note that motors with motor housings are conventional and are widely used throughout industry to protect the inner workings of the motor, thereby increasing the life of the motor by protecting it from damage, and also thereby increasing the motor’s efficiency by keeping it from being degraded by dirt and debris getting into the motor working parts.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided such a well-known rotation-causing device (motor with housing) to rotate the turntable of either of the devices taught by Molleker or Rettie, for the purposes of making it easier for an operator to operate their respective devices, and also to produce a more uniform cut (noting that if the turntables taught by Molleker or Rettie are manually rotated, the cutting pressure maintained between the workpiece mounted on the turntable and the cutting blade will be non-uniform and thus jagged edges may be produced on the workpiece), benefits which would be readily understood by one of ordinary skill in the art,

and particularly since it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192. Note that it furthermore would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided such a motor with a housing for the purposes of protecting the inner workings of the motor, thereby increasing the life of the motor by protecting it from damage, and also thereby increasing the motor's efficiency by keeping it from being degraded by dirt and debris getting into the motor working parts, as is conventionally known.

Allowable Subject Matter

12. Claims 13-18, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claim 26, as best understood, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

No single reference teaches all the limitations of claim 26, and thus the prior art does not anticipate the present invention as set forth in claim 26.

Note that the Painter, Molleker, Rettie, and Luikart references applied above are considered the closest prior art of record to independent claim 26. Painter teaches a gasket forming apparatus in accordance with limitation "a", Molleker and Rettie each teach a gasket manufacturing tool in accordance with limitation "c", and Luikart teaches a tube bending device similar to limitation "b", although it is noted that Luikart does not teach a "rack" that is "activated by a lever" to move the rollers 44.

However, there is no motivation absent impermissible hindsight that would reasonably motivate one having ordinary skill in the art to combine the teachings of Molleker/Rettie with those of Painter and with those of Luikart such that the tooling of each one was applied interchangeably to a single platform. Additionally, it would appear that Luikart is nonanalogous in that it is in the tube-bending art and Molleker/Rettie and Painter are all related to gasket manufacture, and there does not appear to be a common problem solving area between Luikart and any of Molleker, Rettie, and Painter. Additionally, even assuming arguendo that Luikart was considered analogous, there is no teaching or suggestion in the prior art to apply the “rack”/ “lever”/ “rod” system claimed to move the rollers 44 instead of the current lever 50.

For at least the foregoing reasoning, the prior art of record neither anticipates nor renders obvious the present invention, as best understood, in independent claim 26.

Conclusion


1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Faxing of Responses to Office Actions and Contact Information

1. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on Monday through Thursday from 7:30 a.m. to 5:00 p.m., and every other Friday from 7:30 a.m. to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached at (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadugan
Primary Examiner
Art Unit 3722

eec
March 4, 2004